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08/060879

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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D CONNOFEXAMINER

F3M1/0216

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ART UNIT	PAPER NUMBER
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3303

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DATE MAILED: 02/16/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☒ Claims 8-12 are allowed.

4. ☒ Claims 1-3, 6, 7, 13, 15-19, 20 are rejected.

5. ☒ Claims 4, 14 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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Claim Rejections - 35 USC § 112

Claims 19 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 19, the passage "gingival...therebetween" is a double recitation (see claim 17, lines 4-6).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as the Peterson reference at the time this invention was made. Accordingly, the Peterson reference is disqualified as prior art through 35 U.S.C. § 102(f) or (g) in any rejection under 35 U.S.C. § 103 in this application. However, this reference additionally qualifies as prior art under section (e) of 35 U.S.C. § 102 and accordingly is not disqualified as prior art under 35 U.S.C. § 103.

Applicant may overcome the reference either by a showing under 37 CFR 1.132 that the invention disclosed therein was

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derived from the invention of this application, and is therefore, not the invention "by another", or by antedating the reference under 37 CFR 1.131.

Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Peterson.

Claims 15 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ghafari et al. Note the auxiliary slot 22 and the auxiliary shaft portion 24 which have complimentary configurations to restrict rotational movement therebetween.

Double Patenting

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,160,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to use an orthodontic bracket that does not include a base.

Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,160,261 in view of Suyama '925. The sidewalls and floor portions of the Suyama's archwire slots are convex to reduce friction between the bracket and the archwire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sidewalls and floor of '261 convex, as taught by Suyama, to reduce undesirable friction between the archwire and the bracket.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance

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with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over Peterson in view of Suyama '925. The sidewalls and floor portions of the Suyama's archwire slots are convex to reduce friction between the bracket and the archwire. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sidewalls and floor of Peterson convex, as taught by Suyama, to reduce undesirable friction between the archwire and the bracket.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Kesling '832 in view of Kawaguchi. Kesling discloses the claimed invention except for the T-shaped hook on the center leg. Kawaguchi teaches that it is known to locate a T-shaped hook on a tie wing as shown in Figs. 1 and 2. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to provide the center leg of Kesling with a T-shaped hook, as taught by Kawaguchi in order to mount auxiliary force transmitting members thereto.

Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Suyama '925 in view of Ghafari et al. Suyama discloses the claimed invention except for the auxiliary slot positioned under the convex floor portion. Ghafari teaches that it is known to employ an auxiliary slot 22 so that various attachments may be applied to the bracket. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bracket of Suyama with an auxiliary slot under the convex floor portion, in view of Ghafari, so that various appliances may be attached to the bracket.

Claims 17-19 are rejected under 35 U.S.C. § 103 as being unpatentable over Kesling '832. Kesling shows an orthodontic bracket having a base 16, a body portion 33 having a pair of opposed sidewalls 36, 37, gingival and occlusal tie wings 21,22 defining an archwire slot 24 therebetween, and a first auxiliary slot 50 extending from one sidewall to the other sidewall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the bracket with a second auxiliary slot since it has been held that duplication of parts would have been obvious to a skilled artisan. St. Regis Paper Co. v. Bemis Co., Inc., 193 USPQ 8 (7th Cir. 1977).

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Allowable Subject Matter

Claims 8-11 are allowable over the prior art of record.

Claims 4 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary O'Connor whose telephone number is (703) 308-0858.

ceo/d.3
February 15, 1994

Cary E. O'Connor
CARY E. O'CONNOR
PRIMARY EXAMINER
GROUP 330